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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,363	06/07/2001	Robert Henry Rohrbaugh	8407M	2422

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EXAMINER

WOOD, ELIZABETH D

ART UNIT PAPER NUMBER

1755

DATE MAILED: 10/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/876,363

Applicant(s)

ROHRBAUGH ET AL.

Examiner

Elizabeth D. Wood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7/31/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) 20-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **Oath/Declaration**

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52©.

### **Information Disclosure Statement**

The information disclosure statement filed April 29, 2002 requests consideration of copending applications. If applicants wish these documents to be listed on any patent issuing from the instant application, then they should be properly listed on a PTO-1449. Furthermore, with the exception of application Serial No. 09/828,014, the applications have not been considered at this time because the parent application is not immediately available to the examiner so as to obtain copies of the copending applications. If applicants submit copies of the applications and a PTO-1449 listing these applications in response to this office action, they will be considered at that time.

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**Election/Restriction**

Applicants' election with traverse of Group I, claims 1-19, species lithium magnesium fluorosilicates in Paper No. 6 is acknowledged. The traversal is on the ground(s) that there is no undue burden on the examiner because the search for any single group would be expected to yield art that is pertinent to the patentability of the other groups. This is not found persuasive because it is not correct. The burden on the examiner is present because each group has a completely divergent field of search. Although a search of the Group I invention **might** yield art pertinent to another group, it might not yield **all** art pertinent to another group. As a result, for a proper and complete examination, the examiner would be required to search all required areas which would clearly constitute undue burden.

The requirement is still deemed proper and is therefore made FINAL.

**Specification**

The examiner has not checked the specification to the extent necessary to determine the presence of **all** possible minor errors (grammatical, typographical and idiomatic). Cooperation of the applicant(s) is requested in correcting any errors of which applicant(s) may become aware of in the specification, in the claims and in any future amendment(s) that applicant(s) may file.

Applicant(s) is also requested to complete the status of any copending applications referred to in the specification by their Attorney Docket Number or Application Serial Number, **if any**.

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The status of the parent application(s) and/or any other application(s) cross-referenced to this application, if **any**, should be updated in a timely manner.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The claims are indefinite in the recitation of "purified" as it is unclear what this means.

Claim 10 fails to further limit the composition of claim 1. The surface to be treated does not further define the composition under examination.

Claim 11 lacks antecedent basis for "said surfactant".

Claim 17 recites "an effective amount" but fails to set forth for what the amount is effective.

Claim 19 is not further limiting and is confusing. The language "is also capable of" is not a positive limitation on the composition, but rather an inherent property thereof.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 5,429,867 to McCarthy et al. JP 96053558, GB 1,376,379 or the Technical Directory for Laponite.

The instantly claimed composition requires the presence of nanoparticles, i.e. lithium magnesium fluorosilicates, and purified water. Each of the cited references disclose compositions containing, for example, Laponite which is a known lithium magnesium fluorosilicate. The references also disclose the presence of water in the compositions and/or the use of the composition by application form an aqueous slurry or solution. The references differ from the instantly claimed invention in the failure to specify the water as being "purified". However, it is considered that the instant claims would have been obvious because "purified" water is a term that would include, for example, city or tap water. Since the references are silent as to the type of water employed, it is reasonable to conclude that city water may well be the source employed for the patented compositions. It is furthermore well-known to employ the most pure products available to prevent undesired side reactions. In the instant case, one skilled in the art might not want reactions of ions found in tap water to interfere with the effect of the composition and would therefore employ additionally purified water. Such manipulation would clearly be within the purview of the skilled artisan. See particularly page 7 of the

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Technical Directory, column 1 of GB 1,376,379, page 4 of JP 96053558 and column 4 of McCarthy et al.

Any minor differences in the limitations of the dependent claims have been considered.

This statement is meant to include limitations such as the amount of water present in the composition, which the artisan would be expected to manipulate to arrive at a functional composition.

Furthermore, any such differences are deemed to be result-effective variables that one of ordinary skill in the art would be expected to manipulate to advantage. Additionally, such limitations can be considered to have been simply known as conventional to the artisan practicing in the art at the time the invention was made and/or were common practices which were so well known in the art that they would have been taken for granted. MPEP 706.02(a).

If applicants believe that one or more limitations are critical to the invention, then applicant should amend the claims to reflect such critical limitations as well as indicate where in the specification such critical limitations were discussed and demonstrated.

The limitations of all claims have been considered and are deemed to be within the purview of the prior art.

## **Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent



and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of copending Application No. 09/950,757 or claims 1-20 of copending Application No. 10/338,603. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ from one another in the scope of coverage being sought. The copending claims are drawn to a method of making a coating by applying a wet nanoparticle coating composition to a surface or to a method of treating a material with charged particles. In copending Serial No. 09/950,757, the definition of wet includes aqueous material and the nanoparticles include sodium magnesium lithium fluorosilicates. In copending Serial No. 10/338,603, the charged particles are

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nanoparticles such as sodium magnesium lithium fluorosilicates and they are introduced in aqueous material. Accordingly, the composition of the instant claims is specifically recited in the copending claims and therefore would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

## **Conclusion**

Applicants are advised that any evidence to be provided under 37 CFR 1.131 or 1.132 and any amendments to the claims and specification should be submitted prior to final rejection to be considered timely. It is anticipated that the next office action will be a final rejection. Furthermore, the prior art of record is considered to be cumulative to that applied in the above rejection. Accordingly, all the prior art, as well as the elected invention, should be kept in mind when amending the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth D. Wood whose telephone number is 703-308-3802. The examiner can normally be reached on M-F, 5:30-2:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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A handwritten signature in black ink, appearing to read 'Elizabeth D. Wood', written in a cursive style.

Elizabeth D. Wood

Primary Examiner

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edw